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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,762	12/27/1999	CARL H. HAUSER	D/99477	9175

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100 CLINTON AVE. S., XEROX SQ. 20TH FLOOR
ROCHESTER, NY 14644

EXAMINER

LIN, KENNY S

ART UNIT PAPER NUMBER

2154

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/472,762

Applicant(s)

HAUSER, CARL H.

Examiner

Kenny Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-18 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following term lack proper antecedence basis:

- i. Claim 7, line 16 – personal documents (i.e. stored documents).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 5, 9-10, 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Unger et al (hereinafter Unger), US Patent 5,721,910.

6. Unger was cited on the previous office action.

7. As per claims 1, 3 and 5, Unger taught the invention as claimed including a computer-implemented method/computer program product having a computer-readable medium holding computer-executable instructions for performing a method for adding a document to a plurality of stored documents, comprising:

- a. loading the document into storage, said loaded document having a document category (col.2, lines 58-65);
- b. determining the document category of said loaded document (col.3, lines 9-15);
- c. extracting information from said loaded document indicating at least one of a document data, a document transaction type and a document identifier (col.1, lines 21-24, col.6, lines 48-51, col.7, lines 26-51, 55-65, col.8, lines 52-62, col.10, lines 34-65); and
- d. applying to said loaded document at least one document handling procedure associated with the document category of said loaded document (col.3, lines 22-28, col.4, lines 44-57, col.7, lines 40-46): said document handling procedure linking said loaded document to at least one of said plurality of stored documents using the at least one of the document date, the document transaction type and the document identifier extracted from said loaded document (col.4, lines 44-57, col.5, lines 17-35, col.6, lines 48-51, col.7, lines 26-51, 55-65, col.8, lines 52-67, col.9, lines 1-4, 54-60, col.10, lines 34-65).

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8. As per claim 9, Unger taught the invention as claimed in claim 1. Unger further taught that the loaded document further includes document format data specifying whether the loaded document is an electronic document or a document image (col.3, lines 66-67, col.4, lines 1-7).

9. As per claims 10, 13 and 16, Unger taught the invention as claimed in claims 1, 3 and 5. Unger further taught that the document category of the loaded document is determined by data content extracted from the loaded document and matched to pre-determined set of document categories (col.1, lines 21-24, 40-43, col.3, lines 9-15, col.4, lines 44-57, col.6, lines 48-51, col.7, lines 55-65, col.8, lines 52-67).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7, 11, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unger et al (hereinafter Unger), US Patent 5,721,910, in view of Official Notice.

12. As per claim 7, Unger taught the invention substantially as claimed including a method comprising:

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- a. Accessing, on the one or more first computers, computer-executable instructions for adding a document to a plurality of stored document (col.2, lines 58-63, col.13, lines 2-15): the computer-executable instructions when executed by a computer, performing the steps of:
 - i. loading the document into storage, said loaded document having a document category (col.2, lines 58-65);
 - ii. determining the document category of the loaded document (col.3, lines 9-15);
 - iii. extracting information from said loaded document indicating at least one of a document data, a document transaction type and a document identifier (col.1, lines 21-24, col.6, lines 48-51, col.7, lines 26-51, 55-65, col.8, lines 52-62, col.10, lines 34-65); and
 - iv. applying to the loaded document a document handling procedure associated with the document category (col.3, lines 22-28, col.4, lines 44-57, col.7, lines 40-46), said document handling procedure linking said loaded document to at least one other of said plurality of personal documents using the at least one of the document data, the document transaction type and the document identifier extracted from said loaded document (col.4, lines 44-57, col.5, lines 17-35, col.6, lines 48-51, col.7, lines 26-51, 55-65, col.8, lines 52-67, col.9, lines 1-4, 54-60, col.10, lines 34-65).

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13. Unger did not specifically teach the system to transfer the computer-executable instructions from the one or more first computers to the second computer connected to the one or more first computer through a communications medium. However, Unger taught that the method can be implemented in a computer system (col.4, lines 33-43) and that the documents may be on a CD-ROM, in a database, a LAN/WAN or on the Internet (col.1, lines 49-54, col.6, lines 51-55). Furthermore, Unger taught to search for documents and electronically store the results in tables (col.5, lines 56-66) wherein the documents may be stored remotely over the Internet (col.1, lines 49-54, col.6, lines 51-55). Official Notice is taken that both the concept and advantage of transferring computer-executable instruction from one computer to another is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to transfer data files or executable instruction from one computer to another through a medium in a computer system especially in obtaining/requesting data files in LAN/WAN or Internet networks from remote databases. One would have been motivated to send a requesting/searching instruction to a remote computer containing databases to obtain the desired documents from the database. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow users to transfer the computer-executable instruction contained in Unger's system from one computer to another through a communication medium for sharing purposes.

14. As per claims 11, 14 and 17, Unger taught the invention substantially as claimed in claims 1, 3 and 5. Unger did not specifically teach that the document category is determined by a pre-determined category input with the loaded document. However, Official Notice is taken that it would have been obvious to manually assign the document category when loading the

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document. It would have been obvious to one of ordinary skill in the art at the time the invention was made to manually input the document category to the loaded documents.

15. Claims 2, 4, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unger et al (hereinafter Unger), U.S. Patent 5,721,910, in view of MacPhail, U.S. Patent 5,107,419.

16. MacPhail was cited on the previous office action.

17. As per claims 2, 4, 6 and 8, Unger taught the invention substantially as claimed in claims 1, 3, 5 and 7. Unger did not specifically teach the document handling procedure to include retention criteria for determining how long to save the loaded document. MacPhail taught a document classification system to have the document handling procedure to include retention criteria for determining how long to save the document (col.1, lines 59-63, col.3, lines 6-9, 19-21, 26-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Unger and MacPhail because MacPhail's teaching of using retention criteria to determine whether the documents stored in the document storage exceeds expiration date can help the processing rule in Unger's system to automatically delete the documents that are no longer needed to save system storing space (col.1, lines 59-63).

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18. Claims 12, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unger et al (hereinafter Unger), U.S. Patent 5,721,910, in view of Schmidt et al (hereinafter Schmidt), U.S. Patent 6,418,457.

19. As per claim 12, 15 and 18, Unger taught the invention substantially as claimed in claims 1, 3 and 5. Unger further taught to extract a document identifier (col.1, lines 21-24, col.6, lines 48-51, col.7, lines 26-51, 55-65, col.8, lines 52-62, col.10, lines 34-65; patent's unique identifier). Unger did not specifically teach that the document identifier indicating an account number and a transaction date; and wherein the document handling procedure links the loaded document to a set of stored documents having the account number; the document handling procedure further ordering the loaded document among the set of stored documents by the transaction date. Schmidt taught to use the document identifier to indicate an account number and a transaction date; and wherein the document handling procedure links the loaded document to a set of stored documents having the account number; the document handling procedure further ordering the loaded document among the set of stored documents by the transaction date (col.5, lines 23-37, 41-43, 55-56, 65-67, col.6, lines 1-27, 33-38, 43-48, 54-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Unger and Schmidt because Schmidt's teaching of providing documents related to the loaded document using the identifier of the loaded document enables Unger's method to bring up the full history of the loaded document including the previous revisions (col.5, lines 65-67, col.6, lines 1-27).

Response to Arguments

20. Applicant's arguments filed 1/11/2005 have been fully considered but they are not persuasive.

21. In the remark, applicant argued that (1) the Unger reference does not teach the requisite extracting information step. (2) The Unger reference does not teach the requisite document handling procedure. (3) The combination of Unger and MacPhail teach away from establishing any sort of retention scheme because MacPhail teach to manage the retention of a relatively large number of documents that are stored in the system by a plurality of end users is not suitable for Unger.

22. The examiner traverse the argument that:

As to points (1) and (2), examiner has cited new areas in Unger reference to point out that the reference taught to extract information and use a document handling procedure.

As to point (3), in response to applicant's argument that MacPhail is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, MacPhail's teaching of using retention is established by the author/user who files the document to the system (col.3, lines 18-34; when a document is to be filed to the system, the retention and deletion selection criteria must be entered into the system and stored in the system at the same time as the document).

Hence, applicant's argument that "it would seem unreasonable to allow any one user control over when to delete a document..." if Unger reference is combined with MacPhail is incorrect since only administrator or the user who file the document to the system can set to time to retain the document and that the document that expires the time of retention is deleted when it is not needed, not by the control of other users.

Because Applicants have failed to challenge any of the Examiner's "Official Notices" stated in the previous office action in a proper and reasonably manner, they are now considered as admitted prior art. See MPEP 2144.03

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hajmiragha, US 6,289,460.

Chen, US 6,349,307.

Whang et al, US 6,349,308.

Doerre et al, US 6,446,061.

Ferguson et al, US 6,820,094.

Kephart et al, US 2001/0042087.

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

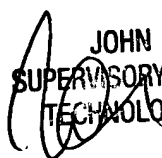
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May 31, 2005

 **JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**